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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN M. DAVIDSON,
AKKAMAPET P. SUNDARRAJ, and
JAMES R. PICKERING

Appeal 2008-0372
Application 09/726,766
Technology Center 2100

Decided: August 20, 2008

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
JEAN R. HOMERE, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1, 3-24, 26-33, and 35-45. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

Appellants invented a method and apparatus for tunneled communication in an enterprise network. (Spec. 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1. A method of communicating with an element within an enterprise network, comprising:
>
> at a first client, encapsulating a first point-to-point protocol signal within a network address request header, the first point-to-point protocol signal comprising a point-to-point protocol header that includes an identifier of a second client; and
>
> communicating the encapsulated signal toward a tunneling server.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Zhang	US 6,108,345 B1	Aug. 22, 2000
Araujo	US 6,301,229 B1	Oct. 09, 2001 (filed Apr. 7, 1998)
May	US 2001/0030977 A1	Oct. 18, 2001 (filed Dec. 21, 2000)
Inoue	US 2002/0007414 A1	Jan. 17, 2002 (filed Apr. 27, 2001)
Shukla	US 2002/0042875 A1	Apr. 11, 2002 (filed Jul. 23, 2001)

Singhal	US 6,633,761 B1	Oct. 14, 2003 (filed Aug. 11, 2000)

REJECTIONS

Claims 1, 3, 12-13, 19-20, 24, 33, and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over May in view of Shukla and Araujo.

Claims 4, 10-11, 14, 18, 21, 23, 28-29, 31-32, 38, and 41-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over May, Shukla, and Araujo in view of Inoue.

Claims 5-7, 15-16, 30, and 35-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over May, Shukla, and Araujo in view of Singhal.

Claims 8-9, 17, 22, 26-27, and 39-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over May, Shukla, and Araujo in view of Zhang.

Rather than reiterate the conflicting viewpoints of the Examiner and Appellants regarding the above-noted rejection, we refer to the Examiner's Answer (mailed Apr. 16, 2007) for the reasoning in support of the rejections, and to Appellants' Brief (filed Sep. 8, 2006) for the arguments thereagainst.

Arguments pointing out patentable subject matter which Appellants could have made but chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(vii) (2005). *See also Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006); *In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered Appellants' Specification and claims, the applied prior art references, and the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we determine the following.

At the outset, we note that the Examiner has not made a rejection under 35 U.S.C. § 101 of claims 12-18 and 42. Therefore, we will not address Appellants' arguments with respect to this issue.

35 U.S.C. § 103(a)

> Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR,* 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1740-41).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

With respect to independent claim 1, from our review of the Examiner's statement of the rejection at pages 3-5 of the Answer and responsive arguments at pages 17-20 of the Answer, we find that the Examiner has at least set forth a sufficient initial showing of obviousness of the invention as recited in independent claim 1. Therefore, we look to Appellants' responsive arguments to show error in the Examiner's initial showing of obviousness.

We note that the issues expressly set forth with respect to the prior art rejections at page 6 of the Brief are not commensurate in scope with the express language as recited in independent claims 1, 12, 19, 24, and 33. Specifically, Appellants' arguments with respect to "encapsulating a first point-to-point protocol signal within a network address header" does not

correspond with the language recited in the independent claims wherein a "network address request header" is set forth. Additionally, the language of the independent claims merely recite communicating a signal "toward a tunneling server" and not that the merits of tunneling server having the argued functionality. Additionally, Appellants argue that Singhal does not teach a first point-to-protocol signal comprising a payload information that is applied to an application and a second client or the payload including at least a portion of an application to be installed on a second client. Therefore, these issues cannot show error in the Examiner's initial showing.

With respect to Appellants' invention, Appellants go to great lengths at pages 7-9 of the Brief to identify and define a "network element" and a "communications system" and the problems encountered with firewalls and tunneling. Appellants set forth numerous aspects of their disclosed invention, but do not clearly correlate those aspects to specific claims and the corresponding claim limitations. Therefore, these generalized discussions do not show error in the rejection of any specific claim. Therefore, we will address Appellants' arguments with regards to independent claims 1, 12, and 24 beginning at page 12 of the Brief.

Appellants maintain that the Examiner's reliance on the teachings of May for converting a first point-to-point protocol signal into a network address request header is completely different than the claimed encapsulating a first point-to-point protocol signal within a network address header. Appellants maintain that "encapsulation" appends information onto the packet to encapsulate the packet whereas "conversion" changes the packet from one format to another format. (App. Br. 12). Here, Appellants' arguments fairly loosely address the express language of independent claims

1, 12, and 24 which recite "a network address request header" rather than the asserted "network address header." Here, Appellants' arguments are not commensurate in scope with the language of the independent claims, and therefore cannot show error in the Examiner's initial showing of obviousness.

Appellants additionally argue that the Examiner's reliance upon the teachings of Shukla to teach packet conversion between protocol layers and encapsulating its own header before transmitting to the next layer does not teach the claimed "encapsulating a first point-to-point protocol signal within a network address request header." Here, the Examiner appears to rely upon the teachings of Shukla for encapsulating the header and the Examiner relies upon the teachings of May for the content of the header which is taught to be encapsulated by Shukla. Here, Appellants argue each individual reference against the totality of the claim limitations rather than the prior art teachings of each reference as applied by the Examiner. Therefore, Appellants' arguments do not show error in the Examiner's initial showing of obviousness of independent claims 1, 12, and 24. Therefore, we will sustain the rejections of independent claims 1, 12, and 24 and their respective claims that have not been separately argued.

With respect to independent claim 19, Appellants argue the teachings of Araujo with respect to communicating the encapsulated signal towards a tunneling server operable to identify the protocol header does not teach the claimed "toward a tunneling server operable to identify the network address request header" (App. Br. 13 and Reply Br. 2). Here again, Appellants argue the Shukla reference individually against the totality of the claim limitations. Here, the Examiner relied upon the teachings of May and Shukla to teach

and suggest encapsulating the network address request header which would then be identified by the tunneling server as taught by Araujo.

Additionally, we note that independent claim 19 recites "[a] method of tunneling . . . communicating the encapsulated signal toward a tunneling server," and Appellants' argument are directed to the functionality of the hardware server whose functions are not positively recited as steps in the method. Therefore, argument thereto is not persuasive of error in the Examiner's initial showing of obviousness. In the Reply Brief at page 2, Appellants argue that the Examiner has "essentially reengineered the prior art in a technically nonsensical manner." We disagree with Appellants' conclusory argument which is based on a bodily incorporation of each of the three references rather than what the combination of teachings would have fairly suggested to one of ordinary skill in the art at the time of invention was made. Therefore, Appellants' argument is not persuasive of error in the Examiner's initial showing of obviousness, and we will sustain the rejection of independent claim 19 and its respective claims that have not been separately argued.

With respect to independent claim 33, Appellants rely upon the arguments advanced with respect to independent claims 1, 12, and 24 which we did not find persuasive of error in the Examiner's initial showing of obviousness. (App. Br. 13-14). We similarly do not find those arguments persuasive with respect to independent claim 33 to the extent that those arguments apply to the varied claim limitations, and, we will sustain the rejection of independent claim 33 and its respective claims that have not been separately argued.

With respect to dependent claims 5 and 15, Appellants argue that the Examiner's reliance on the teachings of Singhal concerning a payload including information that is applied to an application residing at a second client is in error. Appellants argue that Singhal teaches information in a network address request header is applied to the application and not the information in the first point-to-point protocol signal. Appellants argue that the information in the first point-to-point protocol signal is not a mere design choice but one of the aspects of the invention wherein the payload of a point-to- point signal is available to network elements that otherwise could not participate in tunneling. Here, we note that the express limitations of dependent claim 5 do not set forth the argued benefit of other network elements participating in tunneling. Therefore, this argument is not persuasive of error in the Examiner's initial showing of obviousness. (App. Br. 14).

Furthermore, the Examiner addresses this argument at pages 19-20 of the Answer and explains how information contained in the payload and not the header of the message is available to the application. In Appellants' responsive arguments on pages 3-4 of the Reply Brief, Appellants argue that while Singhal teaches that a DHCP response includes a payload with an IP address applied to the first client, Appellants claim recites that first client issues the request but the payload "is applied to a **second client.**" Here again, Appellants do not rely upon the express language of dependent claim 5 wherein dependent claim 5 merely sets forth that the payload including information "to be applied to an application residing at the second client."

The language of dependent claim 5 is directed to and use of the data rather than an actual recited step in the method claim. Therefore,

Appellants' argument is not commensurate in scope with dependent claim 5 and is not persuasive of error in the Examiner's initial showing of obviousness. Additionally, we note that any stored or transmitted information may prospectively be used by any other device receiving the information. Here, the use thereof has not been positively recited in dependent claim 5 and is therefore not entitled to patentable weight to distinguish the Examiner's proffered combination of teachings. Therefore, Appellants' argument is not commensurate in scope with the express language set forth in dependent claim 5 and does not show error in the Examiner's initial showing of obviousness. Therefore, we will sustain the rejection of representative claim 5 and dependent claim 15 grouped therewith by Appellants.

With respect to dependent claims 7 and 16, Appellants dispute the Examiner's reliance upon the AUL table entry used by the core server application and argue that the table entry is a data repository where in the application as claimed is an executable program. Appellants argue that a table entry is completely different than an application. (App. Br. 14-15). Again, we find that Appellants are not arguing the express language of the claim, but rather argue loosely the claim language. Here, the language of dependent claim 7 sets forth "a payload including at least a portion of an application to be installed on the second client." Here, we agree with the Examiner, and we find that the table entry is a portion of an application. Appellants' argument with respect to an "executable program" is not commensurate in scope with the express language set forth in dependent claim 7 and does not show error in the Examiner's initial showing of

obviousness. Therefore, we will sustain the rejection of representative claim 7 and dependent claim 16 grouped therewith by Appellants.

CONCLUSION

To summarize, we have sustained the rejection of claims 1, 3-24, 26-33, and 35-45 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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